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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,952	12/27/2000	Benoit Pol Menez	PU000187	6466

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EXAMINER

LIM, KRISNA

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/748,952

Applicant(s)

MENEZ, BENOIT POL

Examiner

Krisna Lim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the amendment filed 9/8/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-12 remain for examination and claims 13-18 are newly presented for examination.
2. . The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Alten et al. [U.S. Patent No. 6,396,546]. Alten e al. has been used in the last office actions.
4. The rejections are respectfully maintained and incorporated by reference as set forth in the last office action.
5. Applicant's arguments filed 9/08/04 have been fully considered but they are not deemed to be persuasive.
6. In the remarks, applicants argued in substance that:
 - a) Nothing in Alten discloses or suggests that the described system of Alten that such a memory means would or could store "at least one e-mail address."
 - b) Nothing in Alten discloses or suggests the desirability of transmitting the claimed e-mail results of claim 1.
 - c) The pay per view confirmation is not the same thing as "sending an e-mail message to the user at the at least one e-mail address to notify said user of an availability of said television program."
 - d) Alten does not disclose or suggest why a user would want the results of purchasing a movie would or should be transmitted as e-mail to "at least one e-mail address" in the manner suggested by the Examiner.

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7. As to paragraphs 6 a) to 6 d) above and as mentioned in the previous rejection. Using the e-mail method for automatically or electronically passed back and forth information between users/computers through the computer network is a well-known feature in the art at the time the invention made. In addition as suggested by Alten (e.g., see col. 7, lines 53-58), the data stream can be transmitted on the cable line in any number of ways and those of skill in the art will understand that numerous other transmission schemes can be used to transmit the data stream. Thus, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to recognize that such using e-mail to notify the user would have been obvious as one of the numerous transmission schemes as mentioned by Alten.

7. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-12, drawn to a method and an apparatus for notifying a user via an e-mail message of an availability of a television program, classified in Class 709, subclass 206.

II. Claims 13-18, drawn also to a method for recording video program corresponding to matching program guide information using a recording device, classified in Class 725, subclass 105.

8. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the Invention I does not require the step of for recording video program corresponding to matching program guide information using a recording device.

The subcombination has separate utility such as a method for recording video program corresponding to matching program guide information using a recording device lacks

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the steps of notifying a user via an e-mail message of an availability of a television program.

9. These inventions are distinct for the reasons given above, and the search required for each Group is different and not co-extensive for examination purpose.

10. For example, the searches for the two inventions would not be co-extensive because these groups would require different searches on PTO's classification class and subclass as following:

(a) The Group I search (claims 1-12) would require use of search class 709, subclass 206 (which would not required for the group II).

(b) The Group II search (claims 13-18) would require use of search class 725, subclass 105 (which would not required for the group I).

11. Newly submitted claims 13-18 directed to an invention that is independent or distinct from the invention originally claimed for the reasons as indicated paragraphs 7-

10.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 13-18 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD,

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THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

13. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisna Lim whose telephone number is 571-272-3956. The examiner can normally be reached on Monday to Wednesday and Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess, can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

March 4, 2005



KRISNA LIM
PRIMARY EXAMINER